

REMARKS

This is in response to the Office Action mailed March 8, 2006.

Claims 6-10, 13-15, 18, 20 and 22 are cancelled without prejudice or disclaimer of the subject matter therein.

Claims 11, 12, 16, 21 and 25 are amended.

The Rejections.

Claims 1-5, 10-13, 15-19 and 24 are rejected under 35 U.S.C. 103(a) as unpatentable over applicant's submission of prior art (ASPA) in view of McCall et al. (U.S. Patent No. 6,322,667). Claims 21, 22, 24 and 27 are rejected under 35 U.S.C. 103(a) as unpatentable over Barnes (U.S. Patent No. 4,270,774) in view of McCall et al. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as unpatentable over Barnes in view of McCall and Shoemaker, Jr. (U.S. Patent No. 6,796,487). Claim 26 is rejected under 35 U.S.C. 103(a) as unpatentable over Barnes in view of McCall and Horniak (U.S. Patent No. 5,211,093).

The rejection based on ASPA and McCall et al.

Claim 1 is directed to

a roll of tickets comprising a tube, and a plurality of tickets wrapped around the tube, the plurality of tickets having interconnected ends defining rows of perforations therebetween, the plurality of tickets being formed from a substrate having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98%.

At page 3 of the office action it is suggested that

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify ASPA's ticket with a paper substrate having a caliper of 7.3 and an opacity of 98.1% as taught by McCall for providing an alternative paper substrate.

It is well settled that an examiner cannot establish obviousness by locating references which describe various aspects of an applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the applicant has done.¹

¹ See *Ex parte Levingood*, 28 USPQ2d 1300, (BPAI 1993).

Neither ASPA or McCall et al. teach or suggest providing the ASPA tickets from a substrate having a caliper characteristic between 5 and 8 points. ASPA teaches a caliper characteristic of approximately 9.5, not less. McCall et al. discloses a method of treating paper products and discloses paper of various caliper and opacity. McCall et al.'s disclosure is not a teaching or suggestion to use paper having a caliper of a caliper between 5 and 8 points to make a ticket. McCall et al. does not provide a suggestion or motivation to modify ASPA to provide a substrate having a caliper characteristic between 5 and 8 points as recited in claim 1 and it would not have been obvious to one of ordinary skill in the art to combine ASPA and McCall et al. Applicant's declaration accompanies this amendment and evidences that the prior art teaches 9.5 caliper stock as the standard for over 50 years and other caliper stock has not been used.

The declaration also demonstrates surprising results from using substrate of between 5 and 8 points to make tickets. The problems associated with using thinner tickets have discouraged creation of a thinner ticket. In the present instance, there is no persuasive evidence of a motivating force to combine ASPA and McCall et al. in a manner that would have arrived at the invention of claim 1. The reasoning stated for the combination of ASPA and McCall et al. is to provide an alternative paper substrate. The industry has for decades used different substrates for tickets, but such different substrates had 9.5 caliper, not between 5 and 8 points as recited in claim 1.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art.² In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teaching to arrive at the claim invention.³ To this end, the requisite motivation must stem from some teaching suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from appellant's disclosure.⁴

For at least these reasons, the combination of ASPA and McCall et al. would not have been obvious to one of ordinary skill in the art. Claims 2-5 are allowable for at least the same reasons as urged with respect to claim 1.

² See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

³ See *Ex parte Clapp*, 2227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985).

⁴ See, for example, *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 A(Fed. Cir.), cert denied, 488 U.S. 825 (1988).

At pages 4 of the office action it is stated that

it would have been obvious to construct the paper substrate in any desirable caliper and opacity size, since applicant has not disclosed the criticality of having a particular opacity and caliper dimensions, and invention would function equally well in any desirable size dimension.

The caliper of the ticket substrate is critical as explained in the declaration. Applicant's specification is referenced in the declaration and emphasizes the criticality of the substrate thickness. The declaration explains that unexpected results arise from using this range of thickness to make tickets.

For at least these reasons, the combination of ASPA and McCall et al. would not have been obvious to one of ordinary skill in the art.

It is improper to pick from the prior art only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such references fairly suggest to one of ordinary skill in the art.⁵ The above noted rejection of claim 1 appears to pick and choose elements from the ASPA and McCall et al. references without regard for the teachings of such prior art.

The court has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art.⁶ It is apparent that the proposed modification of ASPA to provide paper having a caliper of between 5 and 8 as disclosed by McCall et al. is not motivated by some teaching or suggestion in the prior art. Rather the combination was constructed only after a hindsight review of the applicant's disclosure. The office action does not supply a factual basis for the rejection, but relies on speculation for suggesting the combination. Such hindsight conclusion based on a hindsight review of the applicant's disclosure is improper.

Claim 10 has been cancelled and claims 11, 12 and 16 have been amended to depend from claim 1. Dependent claims 11-12 and 16-17 are allowable for at least these same reasons as claim 1.

⁵ See *In re Kamm*, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972) .

⁶ See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Claim 19 is directed to a plurality of tickets comprising a sheet of reply card stock paper having a caliper in the range of from 5 to 8 points and having perforations defining detachable tickets therebetween. The reasoning stated in the office action is the same as stated with respect to claim 1. Applicant submits that the rejection is improper for the same reasons as expressed above with respect to the rejection of claim 1.

Claim 24 is directed to plurality of tickets being formed from a substrate having a caliper characteristic between 5 and 8 points and an opacity characteristic of less than 98%. Claim 24 is allowable for the same reasoning as noted above with respect to claim 1 regarding the critical range of between 5 and 8 points for tickets, etc.

The rejection of claims 21, 22, 24 and 27 based on Barnes in view of McCall et al.

Claim 21 has been amended to recite the critical caliper characteristic between 5 and 8 points and is allowable for the same reasons as recited above regarding this limitation in claim 1.

The rejection of claims 23 and 25 based on Barnes, McCall et al. and Shoemaker

Claim 23 is dependent on claim 21 and is allowable for the same reasons as claim 21.

Claim 25 is dependent on claim 24 and is allowable for the same reasons as claim 24.

The rejection of claim 26 based on Barnes, McCall et al. and Horniak.

Claim 26 is dependent on claim 24 and is allowable for the same reasons as claim 24.

Additional comments on the above-noted rejections.

The statement that “it would have been an obvious matter of design choice” is used in, for example, the rejection of claims 3, 15 and 17 (page 4 of the office action) and this is a conclusion, not a reason. Accordingly, there is no *prima facie* case and no proper rejection of the claims on this basis.

At, for example, page 4 of the office action it is stated that discovering an optimum value of a result effective variable involves only routine skill in the art. The prior art of record does not establish that any of the claimed elements are a result-effective variable. Therefore, the rejections based on this premise is improper. See *In re Antonie*, 559 F.2d 618, 195USPQ 6 (CCPA 1977) and MPEP 2144.05 at II B and III.

Conclusion.

In view of the above, it is submitted that all of the pending non-withdrawn claims (Nos. 1-5, 11-12, 16-17, 19, 21 and 23-27) are in condition for allowance and such action is, respectfully, requested.

If there is any issue remaining to be resolved, the examiner is invited to telephone the undersigned so that resolution can be promptly effected.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (35481-73372).

Respectfully submitted,
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